

## REMARKS

As a preliminary matter, Applicants traverse the outstanding Office Action for still being nonresponsive. The Examiner has still not answered many of the meritorious arguments presented by Applicants that repeatedly traversed the outstanding rejection based on Donahue (U.S. 5,853,721). Merely repeating the grounds for rejection does not actually answer the specific meritorious arguments that demonstrated why such grounds were incorrect and/or inappropriate. Accordingly, the burden placed upon the Examiner by Section 707.07(f) of the MPEP has still not been satisfied.

For example, with respect to the Examiner's remarks in the very last paragraph on page 5 of the outstanding Office Action, it is irrelevant how broadly the Examiner chooses to interpret the phrase "reply information." The Examiner has never identified any element or information from Donahue that includes all of the recited limitations of the present claims that relate to such reply information. Whatever the Examiner deems from Donahue to be analogous to the reply information of the present invention, the Examiner still must have been able to identify where the "reply unit" in Donahue stores such reply information in a memory. To date, the Examiner has never identified any such features in Donahue, despite the repeated requests from Applicants for the Examiner to do so.

Furthermore, with respect to the Examiner's remarks regarding claim 2 of the present invention, although the Examiner has not established a proper case of inherency (discussed further below), even the asserted case fails to identify all of the recited features and limitations of claim 2. Whether or not the Examiner is correct that a

computer “must” dump or destroy stored information in a memory relating to a connection (which Applicants do not concede), claim 2 of the present invention does not actually recite such particular features or limitations.

The features the Examiner asserts to be “inherent” to Donahue are that *some* stored information in a memory must be destroyed when a connection is broken. Claim 2 of the present invention, on the other hand, specifically recites that the reply information destruction unit of the present invention destroys the reply information that has already been stored in the memory by the reply unit, discussed above. Again, the Examiner has never even identified in Donahue any reply unit which stores such reply information in the first place. Even if Donahue were to “inherently” destroy some memory information when a connection is broken, the Examiner has not even asserted that the destroyed information “must be” the same information stored by the reply unit in a memory. Applicants have argued against these clear deficiencies in the rejection several times now, and the Examiner has still not answered such arguments.

Claims 1-5 and 7 of the present invention again stand rejected under 35 U.S.C. 102(b) as being anticipated by Donahue. Applicants therefore again respectfully traverse this rejection for at least the reasons of record, those discussed above, and as follows. A *prima facie* case of anticipation still has not been established against claims 1-5 and 7 based on Donahue. Accordingly, all of the previous arguments traversing this rejection are incorporated by reference herein. Donahue simply does not support all of the Examiner’s assertions regarding the reference.

As discussed above, the rejection still fails to identify any reply unit in Donahue that contains each and every feature and limitation of claim 1 of the present invention. The Examiner cites only col. 9, lines 25-55, of Donahue for allegedly teaching the reply unit of the present invention, but this cited portion of the reference still fails to read upon all of the recited features of the present invention. The cited portion merely describes a dialog between a sender and a receiver. Nowhere does the cited portion actually teach that any of the dialog (or any other information) is stored in a memory by either of the sender or receiver. Without any such relevant teachings, Donahue simply cannot read upon the present invention.

Applicants again remind the Examiner that he is required to give patentable consideration to all language recited in the claims. An anticipation rejection may not be based solely on the fact that the Examiner considers *some* features of a prior art reference to be the same as some of the features recited in the present claims. A rejection under Section 102 requires that each and every recited feature in the limitation of the claimed invention must be present in the single prior art reference, or anticipation cannot be established. By definition, most novel inventions will contain some features in common with prior art references in the same field of art. Patentability may not be denied based on only such common features when there still exist unchallenged, novel features in the pending claims. Accordingly, the outstanding Section 102 rejection of independent claim 1 of the present invention, as well as its dependent claims, based on Donahue should be withdrawn.

With respect to claim 2 of the present invention specifically, Applicants further traverse the rejection for reasons similar to those discussed above. Even if the Examiner's asserted case for inherency were correct, a *prima facie* case of anticipation has not even been established against claim 2. The asserted case for inherency, however, is not correct. The rationale asserted by the Examiner fails to establish that a computer must dump or destroy stored information when a connection is broken. Instead, the Examiner has only submitted a rationale for why it may be useful to destroy such information.

Inherency may not be established by mere possibilities or probabilities. Section 2112 of the MPEP requires the Examiner to be able to demonstrate how such features must be present in the cited reference, and not merely be possibilities. Even the rationale stated by the Examiner on page 3 of the outstanding Office Action fails to meet this standard.

Moreover, when inherency is challenged, the Examiner is supposed to submit objective evidence on the record that proves that the allegedly inherent features must be present. No such proof, however, has been submitted on the record. The Examiner's own personal opinion, which is the only support on the record for inherency, may not be used as the objective proof. Although the Examiner has not used the word "inherent" in the prior Office Actions, the Examiner has nevertheless asserted that the same claim features from claim 2 were present in Donahue. Applicants though, have repeatedly challenged this assertion, and therefore the Examiner was obligated to submit

any extrinsic evidence as proof at this time. Because no such evidence appears on the record, the assertion of inherency must be withdrawn.

With respect to claim 7 of the present invention specifically, the asserted anticipation rejection is further deficient on its face. Even though Applicants specifically pointed out to the Examiner that the cited portion of Donahue (col. 8, lines 1-19) fails to teach any port number, as clearly recited in claim 7, the Examiner has nevertheless repeated the same rejection without even commenting on this clear deficiency in the reference. Claim 7 of the present invention requires that the reply information stored by the reply unit is associated with both an IP address and a port number corresponding to the connection. The portion of Donahue that the Examiner still relies upon, however, fails to describe anything related to these features of the present invention. The anticipation of claim 7 specifically is therefore clearly deficient on its face for at least these additional reasons.

Nevertheless, although no amendments to the claims are necessary for at least the reasons discussed above, independent claims 1 and 4-5 have been amended herein solely in the interests of expediting prosecution. By redundantly clarifying some of the features argued above, the inapplicability to the present invention of the cited art of record is more significantly emphasized. Specifically, the claims now more clearly illustrate how the recited reply information is actually a reply to a request issued by the other data communication device. As discussed above, none of the cited portions from the several prior art references describe any such analogous elements. Accordingly, the rejection should be withdrawn for at least these still further reasons as well.

Claims 1-5 and 7 now also stand rejected under 35 U.S.C. 102(e) as being anticipated by Gordon et al. (U.S. 6,671,729). Applicants therefore traverse this rejection for reasons similar to those discussed above in traversing the rejection of these same claims based only upon Donahue. Similar to the rejection discussed above, this rejection also fails to consider all of the actual language recited in the present claims.

For example, the rejection fails to identify any “reply unit” in Gordon that can read upon all of the features and limitations of the reply unit of the present invention. The Examiner asserts that an equivalent reply unit is allegedly taught at col. 7, lines 29-41 of Gordon, but this text portion does not support the Examiner’s assertion. The cited text does refer to “information acquired in block 410 (see Fig. 4), but Gordon never teaches that such information is itself stored in a memory. Instead, Gordon clearly teaches that the acquired information is only used by block 412 “*together* with information from storage or memory block 220.” (Col. 7, lines 37-41, emphasis added). In other words, although Gordon teaches that the acquired information is utilized together with information stored in a memory, Gordon unambiguously teaches that the acquired information is different from the information stored in the memory. Accordingly, the portion of Gordon relied upon by the Examiner cannot read upon the reply unit of the present invention. The anticipation rejection based on Gordon is therefore deficient for at least these reasons.

With respect to claim 2 of the present invention specifically, Applicants further traverse the rejection for reasons similar to those discussed above in traversing the rejection of claim 2 based only upon Donahue. Similar to the rejection above, the

Examiner does not actually assert that Gordon teaches the reply information destruction unit of the present invention. Instead, the Examiner merely repeats that such features must be “inherent.” As discussed above in detail though, the rejection has not established a proper case for inherency. No extrinsic evidence been introduced into the record to support the Examiner’s own personal opinion that Gordon’s disclosure must contain such features, as opposed to such features being mere possibilities. For at least these reasons therefore, the rejection of claim 2 based on Gordon is further traversed.

With respect to the rejection of claim 7 specifically, Applicants also further traverse this rejection as well for reasons similar to those discussed above. Nothing in the cited text from col. 7, lines 42-52, of Gordon describes anything relating to a port number, or more particularly, a port number utilized as clearly recited in claim 7 of the present invention. Accordingly, the rejection of claim 7 based on Gordon is also clearly deficient on its face, and should be withdrawn.

Claims 1 and 4-5 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically, the Examiner asserts that one of ordinary skill in the art would not understand the phrase in claim 1 of the present invention that recites how the reply unit is configured to “transmit reply information corresponding to a request issued by the external communication device.” Applicants traverse this rejection because the Examiner has provided no explanation for how one of ordinary skill in the art would actually fail to understand this phrase when the claim is read in light of the present Specification. In fact, the Examiner appears to be basing the rejection on the fact that Applicant has not explained to the Examiner a narrower definition of “reply information”

to the Examiner's satisfaction. (See paragraph 16 of the outstanding Office Action). Applicants are not obligated to make any such further narrowing explanation, when the claim terms are clearly defined in the present Specification.

Applicants note that the Examiner does not assert that Figs. 1 and 5 of the present Application, nor their accompanying text, are in any way unclear. The rejection is therefore inappropriate because the claim terms are being considered in a vacuum. The correct standard though, is that the claims must be considered in light of at least the accompanying portions of the present Application, as well as the Application as a whole. Upon reviewing the Disclosure and the drawings of the present Application, the Examiner should have no difficulty seeing how one of ordinary skill in the art would understand the plain meaning of the claimed phrase at issue. Any further, narrowing explanation of the terms, as requested by the Examiner, would be new matter if not supported by the Application already.

Applicants further point out to the Examiner that the pending claims are apparatus claims, and not method claims. The Examiner appears to be asserting that the claims are indefinite because they do not define the order of steps or causation within the context of only one element of the apparatus. Applicants therefore traverse any attempt by the Examiner to read process limitations into these device claims.

The Examiner will please note that claim 7 has been amended herein to correct for a minor typographical/grammatical error only. This amendment is not in response to any of the outstanding substantive rejections, and the Examiner should see that the scope of claim 7 has not been affected by this minor correction.

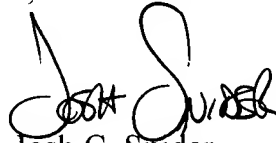


For all of the foregoing reasons, Applicants submit that this Application, including claims 1-5 and 7, is in condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

Respectfully submitted,

GREER, BURNS & CRAIN, LTD.

By

A handwritten signature in black ink, appearing to read "Josh C. Snider", is written over a printed name.

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